

### **REMARKS/ARGUMENTS**

This Amendment is filed in response to the Final Office Action dated December 24, 2008. In the Office Action: (1) Claims 33-35, 46-49, and 54-56 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 7,035,856 to Morimoto ("*Morimoto*") in view of U.S. Patent Publication No. 2004/0093312 to Cordery, et al. ("*Cordery*"); (2) Claims 36-43, 52-53, and 57-60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of *Cordery*, and further in view of U.S. Patent 5,774,885 to Delfer, III ("*Delfer*"); and (5) Claims 44 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of *Cordery*, and *Delfer*, and in further view of U.S. Patent Publication No. 2002/0077847 to Thiel ("*Thiel*") and U.S. Patent Publication No. 2002/0032643 to Himmelstein ("*Himmelstein*"). For the Examiner's reference, Claims 1-32 and 61-71 were previously withdrawn, and Claims 33-60 remain currently pending in the application for further consideration.

#### **Claim Rejections under 35 U.S.C. § 103(a)**

In the Office Action, Claims 33-60 are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of *Morimoto*, *Cordery*, *Delfer*, *Thiel*, and *Himmelstein*. (Office Action, pages 4, 9, and 14). For at least the following reasons, Applicant respectfully requests that the rejections of Claims 33-60 under 35 U.S.C. § 103(a) be withdrawn.

#### ***Rejection of Independent Claim 33***

Applicant respectfully asserts that *Morimoto* fails teach or suggest each and every limitation of independent Claim 33. In particular, independent Claim 33 recites, "an initial carrier computer system ... configured to determine whether the consignee address matches a rural destination classification or an urban destination classification; configured to instruct the initial carrier physical delivery system to deliver the package to the consignee address in response to the consignee address matching the urban destination classification; and configured to determine an intermediate location at which a subsequent one of the carriers is

configured to receive the package in response to the consignee address matching the rural destination classification.” (Emphasis Added).

In particular, Morimoto appears to disclose an “optimization program configured to search out the most efficient routing for the package.” Col. 9, lines 24-25. However, Morimoto’s program only searches for the most efficient routing and does not determine whether consignee address matches a first or second destination classification much less a rural or urban destination classification. Furthermore, the Examiner even asserts that Morimoto does not explicitly teach that the first classification is an urban destination classification and the second is a rural destination classification.

To make up for the deficiencies of *Morimoto* the Examiner cites *Cordery*. *Cordery* allegedly teaches, “the first classification is an urban destination classification and the second is a rural destination classification.” See Office Action, pg. 5. However, Applicant respectfully disagrees with the Examiner’s assertion that *Cordery* teaches an initial carrier computer system configured to determine whether the consignee address matches a rural destination classification or an urban destination classification. *Cordery* appears to disclose a metering system wherein, “the closed loop postage metering system can offer discounts to the mailer or to the recipient for allowing and accepting an offer of delayed delivery or an offer of delivery by an alternate carrier that happens to be delivering on a particular rural route that day.” (Paragraph 0081). *Cordery* does not disclose determining if an address matches a rural destination classification or an urban destination classification. Furthermore *Cordery* does not disclose support for how the determination of a rural and urban classification is done. *Cordery* only states that a discount can be given if the package can be delayed or sent by another carrier on a particular rural route. In addition, the Examiner has made an assumption interpreting, “an urban destination classification as one that is not specifically for a rural delivery.” Even if the Examiner’s assumption is considered correct, *Cordery* does not teach an initial carrier computer system configured to determine whether the consignee’s address matches a rural destination classification. As a matter of fact, *Cordery* does not even mention an initial carrier computer system or any type of computer system that determines if a consignee’s address matches the above destination classifications.

In *Cordery*, the determination of using an alternative carrier is based on more criteria than disclosed in the Applicant's invention. *Cordery* requires that the delivery be on a **rural route and an alternate carrier be available on that particular day**. (Paragraph 81). Both requirements have to be met before the delivery of an alternative carrier can be offered. However, the Applicant's invention does not require the determination of a second carrier based by the availability of the carrier on "a particular rural route that day." Applicant's invention determines "whether the consignee address matches a rural destination classification or an urban destination classification." If the address matches a rural destination "an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the rural destination classification." Applicant respectfully asserts that the present application requires less criteria, in particular, the application does not require an alternate carrier be available on that particular day, which is taught by *Cordery*.

Since both of the cited references fail to teach or suggest a rural destination classification or an urban destination classification, the cited references, even if combined, do not teach or suggest all of the recitations of independent Claim 33. For this reason, Applicant respectfully submits that independent Claim 33 is patentable over *Morimoto* in view of *Cordery*. Applicant, therefore, respectfully requests that the rejection of independent Claim 33 be withdrawn.

#### ***Rejection of Independent Claim 46***

Applicant respectfully asserts that *Morimoto* does not teach or suggest each and every limitation of independent Claim 46. In particular, independent Claim 46 recites a method of "determining whether the consignee address matches a rural destination classification or an urban destination classification; instructing the initial carrier delivery system to deliver the package to the consignee address in response to the consignee address matching the urban destination classification; and determining an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the rural destination classification." The Examiner even states that "Morimoto does not explicitly teach that the first classification is an urban destination classification and the second is a rural destination classification." To make up for the deficiencies of *Morimoto* the Examiner

cites *Cordery* as teaching the previously mentioned element. However, Applicant respectfully disagrees.

*Cordery* fails to teach or suggest the above recitations, and in particular, a method for determining whether the consignee address matches a rural destination classification or an urban destination classification. Furthermore, *Cordery* does not even make a distinction between urban and rural destinations. *Cordery* only states that a discount can be given if the package can be delayed or sent by another carrier on a particular rural route on a particular day.

Since both of the cited references fail to teach or suggest a rural destination classification or an urban destination classification, the cited references, even if combined, do not teach or suggest all of the recitations of independent Claim 46. For this reason, Applicant respectfully submits that independent Claim 46 is patentable over *Morimoto* in view of *Cordery*. Applicant, therefore, respectfully requests that the rejection of independent Claim 46 be withdrawn.

#### ***Rejection of Independent Claim 54***

Applicant respectfully asserts that *Morimoto* does not teach or suggest each and every limitation of independent Claim 54. In particular, independent Claim 54 recites a computer-readable program code portions comprising, “a second executable portion for determining whether the consignee address matches a rural destination classification or an urban destination classification... and ... a fourth executable portion for determining an intermediate location at which a subsequent one of the carriers is configured to receive the package in response to the consignee address matching the rural destination classification.”

The Examiner asserts for Claim 54 that *Morimoto* does not explicitly teach an urban destination classification and a rural destination classification. However, the Examiner asserts that *Cordery* teaches the previously mentioned classifications. As discussed above, Applicant disagrees with the Examiner’s assertion. *Cordery* does not make a determination between a rural destination classification or an urban destination classification. Furthermore, neither *Morimoto* nor *Cordery* teach or suggest a computer-readable program code portions comprising a second executable portion for determining whether the consignee address matches an urban destination classification and a rural destination classification.

In particular, Morimoto appears to only disclose an "optimization program configured to search out the most efficient routing for the package." Col. 9, lines 24-25. *Morimoto's* program only searches for the most efficient routing and does not determine whether consignee address matches a first or second destination classification much less a rural or urban destination classification. *Cordery* likewise fails to fulfill the deficiencies of Morimoto as previously mentioned.

Since both of the cited references fail to teach or suggest a rural destination classification or an urban destination classification, the cited references, even if combined, do not teach or suggest all of the recitations of independent Claim 54. For this reason, Applicant respectfully submits that independent Claim 54 is patentable over *Morimoto* in view of *Cordery*. Applicant, therefore, respectfully requests that the rejection of independent Claim 54 be withdrawn.

#### ***Rejection of Dependent Claims 36-43, 50-53, and 57-60***

On Pages 9-14, Items 19-35 of the Office Action, the Examiner has rejected dependent Claims 36-43, 50-53, and 57-60 under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of *Cordery*, and further in view of U.S. Patent 5,774,885 to Delfer ("*Delfer*"). Dependent Claims 36-43, 50-53, and 57-60 depend from independent Claims 33, 46, and 54, respectively, and therefore include all the limitations of these independent claims plus additional limitations that further define the invention over the prior art. Accordingly, Applicant respectfully submits that dependent Claims 36-43, 50-53, and 57-60 are patentable over *Morimoto* in view of *Delfer* as such dependent claims depend from allowable base Claims 33, 46, and 54.

#### ***Rejection of Dependent Claims 44 and 45***

On Pages 14-15, Items 36-38 of the Office Action, the Examiner has rejected dependent Claims 44 and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Morimoto* in view of *Cordery* and *Delfer* in further view of U.S. Published Patent Application 2002/0077847 to Thiel ("*Thiel*") and U.S. Published Patent Application 2002/0032643 to Himmelstein ("*Himmelstein*"). It is respectfully submitted that the Examiner has engaged in piecemeal examination in which the

Examiner has attempted to dissect Claims 44 and 45 rather than to consider them “as a whole” as required under 35 U.S.C. 103(a). The rejection was thus improper for this reason. *See Diamond v. Diehr*, 450 U.S. 175, 176 (1981) (noting that claims must be considered as a whole, it being inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis); *Princeton Biochemicals, Inc., Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005) (holding that section 103 specifically requires consideration of the claimed invention as a whole; without this important requirement, an obviousness assessment might successfully break an invention into its component parts and then find a prior art reference corresponding to each component); *Ex Parte Takeshi Yamamori*, 2002 WL 230623, 2 (Bd.Pat.App. & Interf.) (noting that the examiner cannot dissect the claim limitations; rather, they must be considered as a whole).

The Examiner has attempted to dissect Claim 44 and 45 by extracting each limitation from the context claimed. Each separate element of the claim is rejected by a different reference. The Examiner has combined a shipping system (*Morimoto*), a postage metering system (*Cordery*), and a billing system (*Delfer*) with a system for communication shipping orders (*Thiel*) and a bartering system (*Himmelstein*). The Examiner combined the references based on the alleged knowledge of one of ordinary skill in the art; however the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. (MPEP 706.02(j); *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Applicant respectfully asserts that the Examiner does not present a convincing line of reasoning for combining the references. The Examiner gives no convincing reason as to why one skilled in the art would combine the five different systems of the alleged prior art (i.e., the bartering system, the shipping system, the postage metering system, and the billing system). Instead, the Examiner makes a cursory conclusion that “[i]t would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of *Himmelstein* [and *Thiel*] because this as well is merely a combination of old elements that would produce only predictable results and could be implemented through routine engineering.” However, the Examiner does not present a convincing line of reasoning as to why, for example, it would have been obvious to one

of ordinary skill in the art to combine the multiple systems and why the result would have been predictable. It appears that the Examiner has improperly rejected the claims as allegedly a combination of old elements. See MPEP 2173.05(j) ("With the passage of the 1952 Patent Act, the courts and the Board have taken the view that a rejection based on the principle of old combination is NO LONGER VALID")(emphasis in original). Furthermore the Examiner does not provide any documentary evidence to support his conclusions for instance that the result would have been predictable and could have been implemented through routine engineering. See MPEP 2144.03.

### *Thiel*

In particular, the Examiner admits that for Claim 44, the combination of *Morimoto* in view of *Cordery* and *Delfer* do not explicitly teach, "initial carrier computer system is configured to: control receipt of funds from the shipper computer system for payment of the invoice; debit an amount of the funds for shipment services provided by the initial carrier." However, the Examiner continues asserting that the above claim elements are taught by *Thiel*. Applicant respectfully disagrees and traverses the combination.

The abstract of *Thiel* discloses, "[a] selection of a carrier is made from a number of available carriers according to at least one predetermined selection criterion. This selection can ensue before or after receipt of the shipping order by the intermediary. The intermediary relays the shipping order to the selected carrier." *Emphasis added.* The Examiner cites paragraph 0058 which discloses, "[t]he intermediary's data processor can be configured for accessing a shipper account for reducing the shipper account by a billed amount." *Thiel* does not teach or suggest, an initial carrier computer system configured to control receipt of funds from the shipper computer system for payment of the invoice and debit an amount of the funds for shipment services. The intermediary described in the abstract relays the shipping order to the selected carrier and is not a carrier, much less an "initial carrier" as described in Claim 44. Furthermore, Figure 1 reiterates that the intermediary is clearly distinct from the carriers. Therefore, *Thiel* only describes an intermediary which is different from an initial carrier and consequently the intermediary cannot be an initial carrier computer system.

*Himmelstein*

The Examiner admits that for Claim 44, the combination of *Morimoto* in view of *Cordery* and *Delfer* do not explicitly teach, "initial carrier computer system is configured to ... deposit a remaining amount of the funds in an escrow account." However the Examiner continues exerting that the deficiencies of *Morimoto* in view of *Cordery* and *Delfer* are taught by *Himmelstein*. However, Applicant respectfully disagrees with the Examiner's assertion.

*Himmelstein* is concerned with providing an electronic bartering system for bartering items or securities under agreed upon conditions. See Column 2, Lines 31-45. This allows a plurality of parties, each having one or more classes of items available for barter, to barter among themselves. See Abstract. Thus, the present application is concerned with the field of delivering packages via a plurality of carriers and *Himmelstein* is concerned with the unrelated field of bartering. Therefore, *Himmelstein* is not from the same field of endeavor.

Furthermore *Himmelstein* does not even mention an initial carrier or placing remaining funds in an escrow account. *Himmelstein* appears to only disclose placing funds for a transaction into an escrow account and not the remaining funds into an escrow account.

Accordingly, Applicant respectfully submits for the above reasons that the Examiner's rejection of Claims 44 and 45 as obvious in light of *Morimoto* in view of *Delfer* in further view of *Thiel* and *Himmelstein* is improper. Thus, Applicant respectfully requests the Examiner to withdraw the current rejection of dependent Claims 44 and 45.



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**CONCLUSION**

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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